

REMARKS

Reconsideration of this application is respectfully requested. Claims 1 and 3-8 are pending in the application. It is submitted that this Remarks is fully responsive to the Office Action dated January 2, 2009.

Claim Rejections - 35 U.S.C. §112

Claims 7 and 8 are rejected under 35 U.S.C. §112, second paragraph, as including indefiniteness.

This rejection is respectfully traversed. It is submitted that the Examiner appears to have a problem in construing several recitations of claim 7.

Frame renewer

Specifically, with regard to “frame renewer,” the Examiner alleges that as best understood, at this junction, a frame renewer is an image or frame reproducer (please see page 3, item 10 of the Action).

However, it is submitted that claim 7 recites a reproducer which sequentially reproduces an image signal of a plurality of frame recorded in a recording medium in accordance with an arbitrary time series. In other words, the reproducer of claim 7 sequentially reproduces image signals of frames in an arbitrary time series.

On the contrary, the frame renewer renews frames at renewing timings according to a predetermined renewing interval. Therefore, the frame renewer includes different feature from reproducer.

First renewer

With regard to “first renewer which renews a frame currently being reproduced at an accepting timing of the operation to a frame to be subsequently reproduced,” the Examiner alleges that this is merely the reproduction of sequential frames (please see page 3, item 11 of the Action).

However, the first renewer is included in the frame **renewer** which is already discussed above. Moreover, the Examiner omits the feature of “first renewer renews a frame when an operation for shortening said renewing interval is made by said changer.” Therefore, it is different from mere reproduction of sequential frames.

Second renewer

With regard to “second renewer which renews a frame currently being reproduced at an accepting timing of the operation to a frame to be subsequently reproduced with a renewing timing that the renewing interval between the frame currently being reproduced and a frame to be subsequently reproduced becomes equal to the renewing interval changed by said changer,” the Examiner alleges that this is merely sequentially reproducing a set of frames, while maintaining the renewal period equal to a period of reproduction (please see page 4, item 12 of the Action).

However, the second renewer is also included in the frame renewer. Moreover, the Examiner omits the feature of “second renewer renews a frame *when an operation for prolonging said renewing interval is made by said changer.*” Therefore, it is different from mere reproduction of sequential frames. Moreover, “*the renewing interval...becomes equal to the renewing interval changed by said changer.*” This changed interval is different from merely maintaining the renewal period equal to a period of reproduction as alleged by the Examiner.

Claims 7 and 8 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

This rejection is respectfully traversed.

It is believed that the above discussion regarding **indefiniteness rejection** may make the Examiner have clear interpretation of claim 7. It is also believed that the Examiner may find support for claim 7 based on such interpretation together with the following explanation.

The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991).

Moreover, if a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. In other words, the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient. *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972).

Frame renewer

This claim element is supported by, for example, by the specification (page 7, lines 8-12).

First renewer

This claim element is supported by, for example, the specification (page 7, line 13 to page 8, line 11).

Second renewer

This claim element is supported by, for example, by the specification (page 6, line 24 to page 7, line 4 and page 10, lines 1-4).

Claim Rejections - 35 U.S.C. §101

Claim 6 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

This rejection is respectfully traversed. At the outset, the Examiner cited several U.S. Supreme Court cases and *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

The *Bilski* court stated three rules:

- (1) Whether the effect of allowing the claim would be to allow the patentee to pre-empt substantially all uses of that fundamental principle. If so, the claim is not drawn to patent-eligible subject matter. In other words, if a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself, the claimed process is surely patent-eligible under § 101.
- (2) The machine-or-transformation test in which an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.
- (3) The involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.

As to Rule 1

Claim 6 is directed to an image processing method, NOT a so-called “business method.” Claim 6 includes the steps of reproducing still image signals recorded in a recording medium, restarting a timer, controlling image renewal instruction. Accordingly, claim 6 does not pre-empt any fundamental principle itself. Rather, it encompasses only a particular application of a fundamental principle. Accordingly, claim 6 should be patent-eligible under 35 U.S.C. §101.

As to Rule 2

Transformation test

With regard to transformation test, specifically, transformation of data representing physical objects or substances, the *Bilski* court held that:

That [independent] claim did not specify any particular type or nature of data; nor did it specify how or from where the data was obtained or what the data represented. In contrast, we held one of Abele's dependent claims to be drawn to patent-eligible subject matter where it specified that 'said data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner.' Abele, 684 F.2d at 908-09. This data clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible.

We further note for clarity that the electronic transformation of the data itself into a visual depiction in Abele was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented. We believe this is faithful to the concern the Supreme Court articulated as the basis for the machine-or-transformation test, namely the prevention of pre-emption of fundamental principles. So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle (emphasis added).

Moreover, with regard to "article," the *Bilski* court indicated that:

Applicants' process as claimed does not transform any article to a different state or thing. Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances (emphasis added).

In claim 6, an image signal is reproduced and renewed. This manipulation of data is totally different from the manipulation of public or private legal obligations or relationships, business risks, or other such abstractions. Moreover, the image signal represents physical substance of a screen of still image, which specifies particular type or nature of data; further specifies how or from where the data was obtained or what the data represented.

Machine test

Moreover, claim 6 calls for “*reproducing one screen of still image signal from said recording medium every time that a time of a timer for measuring an image reproducing period elapses,*” “*reproducing one screen of still image signal from said recording medium, without waiting for a lapse of said timer” and “*restarting said timer every time that said one screen of still image signal is reproduced.*” As shown in the above-described steps, claim 6 is tied to particular machines such as “**recording medium**” and “**timer.**”*

In summary, claim 6 meets both of the transformation test and the machine test. Accordingly, claim 6 should be patent-eligible under 35 U.S.C. §101.

As to Rule 3

The reproduction and renewal of the image signal are significant solution in claim 6. Also, the restart of the timer is significant solution. Accordingly, claim 6 should be patent-eligible under 35 U.S.C. §101.

Claim Rejections - 35 U.S.C. §103

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (USP 7,177,523) in view of Okabayashi et al. (USP 6,751,399) and further in view of Ohmori et al. (USP 6,678,397).

This rejection is respectfully traversed. Claim 1 recites the claimed feature of “*an issuer for issuing the image renewal instruction in response to the period changing instruction, wherein said issuer issues the image renewal instruction when the period changing instruction is for shortening the image reproducing period and said issuer stops issuing the image renewal instruction when the period changing instruction is for extending the image reproducing period, such that only in a case of shortening the image reproducing period, the image is renewed in response to the issue of the image renewal instruction.*” Independent claim 6 also includes similar feature.

With regard to the feature of “*such that only in a case of shortening the image reproducing period, the image is renewed in response to the issue of the image renewal instruction,*” the Examiner relies on Ohmori. However, the Examiner finishes her reasoning by incomplete sentence (please see page 8, item 8 of the Action,). Therefore, the Examiner fails to establish a *prima facie* case of obviousness. Therefore, the applicant is under NO obligation to submit evidence of nonobviousness. However, in order to expedite the examination process, Applicants respectfully traverse the rejection as discussed below.

The object of Ohmori is to provide a medical image filing system which reduces time to search and reproduce image data stored in a large-capacity image recording device.

To achieve this object, Ohmori pre-read out required examination image data from the large-capacity recording device 15, and copy in advance and store them in the small-capacity recording device 14 or the image reproducing device 16 (please see Col. 13, lines 50-58). Please note that this structure is repeatedly described in Ohmori (e.g. Col. 2, lines 23-44).

This structure of Ohmori including pre-reading out and storing the specified data in advance is different from and silent regarding the feature of “such that only in a case of shortening the image reproducing period, the image is renewed in response to the issue of the image renewal instruction.”

In view of the above, even if, assuming *arguendo*, that Matsumoto may be combined with Okabayashi and Ohmori in the manner suggested by the Examiner, such combination would still fail to disclose or fairly suggest the claimed feature of “*such that only in a case of shortening the image reproducing period, the image is renewed in response to the issue of the image renewal instruction,*” as called for in claim 1 and similarly in claim 6.

Accordingly, claims 1 and 6 distinguish over Matsumoto, Okabayashi and Ohmori.

Claims 3-5 are dependent from claim 1 and recite the additional features set forth therein. Accordingly, claims 3-5 also distinguish over Matsumoto, Okabayashi and Ohmori for at least the reasons set forth above.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okabayashi et al. (USP 6,751,399) in view of Matsumoto et al. (USP 7,177,523).

This rejection is respectfully traversed. Claim 7 calls for “a first renewer which renews, when an operation for shortening said renewing interval is made by said changer, a frame currently being reproduced at an accepting timing of the operation to a frame to be subsequently reproduced.”

As discussed in the above rejection under 35 U.S.C. §112 second paragraph (indefiniteness), the Examiner had a problem with the interpretation of claim 7. More specifically, the Examiner appears to interpret the above-mentioned claimed feature as “to shorten the renewal interval, as well to adjust the renewal interval, which reads upon the limitation” (please see page 14, lines 5-6 of the Action). According to this interpretation, the Examiner relies on the disclosure of Matsumoto.

However, the Examiner's interpretation mischaracterizes the feature that the first renewer renews, a frame currently being reproduced at an accepting timing of the operation to a frame to be subsequently reproduced when an operation for shortening said renewing interval is made by said changer. The Examiner's interpretation of claim 7 does not include the renewal of the frame when an operation for shortening said renewing interval is made by said changer.

It is submitted that Matsumoto is silent regarding the feature that the first renewer renews, a frame currently being reproduced at an accepting timing of the operation to a frame to be subsequently reproduced when an operation for shortening said renewing interval is made by said changer.

In view of the above, even if, assuming *arguendo*, that Okabayashi may be combined with Matsumoto in the manner suggested by the Examiner, such combination would still fail to disclose or fairly suggest the claimed feature of "*a first renewer which renews, when an operation for shortening said renewing interval is made by said changer, a frame currently being reproduced at an accepting timing of the operation to a frame to be subsequently reproduced,*" as called for in claim 7.

Accordingly, claim 7 distinguishes over Okabayashi and Matsumoto.

Application No.: 10/700,518
Art Unit: 2621

Request for Reconsideration under 37 CFR §1.111
Attorney Docket No.: 032085

Claim 8 is dependent from claim 7 and recites the additional features set forth therein. Accordingly, claim 8 also distinguishes over Okabayashi and Matsumoto for at least the reasons set forth above.

In view of the foregoing, it is submitted that all pending claims are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP


Tsuyoshi Nakamura

Limited Recognition No. L0396

Telephone: (202) 822-1100

Facsimile: (202) 822-1111

TN/ya
Encl.: Limited Recognition